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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,809

07/14/2006

Shinji Okamoto

NIS-16657

7041

40854 7590 01/26/2010

RANKIN, HILL & CLARK LLP

38210 Glenn Avenue

WILLOUGHBY, OH 44094-7808

EXAMINER

FIGUEROA, FELIX O

ART UNIT

PAPER NUMBER

2833

MAIL DATE

DELIVERY MODE

01/26/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,809	Applicant(s) OKAMOTO ET AL.	
	Examiner Felix O. Figueroa	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,5 and 7-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/29/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizaka (JP-06-111869) in view of Simpson et al. (US 5,096,426).

Regarding claim 4, Ishizaka discloses a connector chip comprising a rectangular parallelepiped insulating substrate (21) having six surfaces, and a plurality of conductive paths (22) formed on an outer peripheral surface, which is constituted by four continuous surfaces of the six surfaces, at a predetermined interval in an opposing direction of reaming two opposing surfaces of the six surface, and running round on the outer peripheral surface. Ishizaka also discloses at least a pair of the surfaces opposing to each other among the four surfaces, insulating layers (between adjacent 22s) having a property of repelling molten solder are formed respectively between portions of two adjoining conductive paths among the plurality conductive paths, located on the pair of the surfaces.

Ishizaka discloses substantially the claimed invention except for the specific material of the insulating layers. Simpson teaches the use of insulating layers (54) formed of an epoxy resin (col. 4 lines 65-68). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an epoxy resin as the

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preferred material in order to provide a known and reliable insulation, and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design preference. *In re Leshin*, 125 USPQ 416.

Regarding claims 8 and 9, Ishizaka discloses in the insulating substrate, a plurality of conductive-path-formed portions where the conductive paths are formed and a plurality of conductive-path-unformed portions where the conductive paths are not formed are alternately arranged along a center line so that the conductive-path-formed portions and the conductive-path-unformed portions share the center line. Ishizaka discloses substantially the claimed invention except for a width of each of the conductive-path-formed portions orthogonal to the center line is smaller/larger than a width of each of the conductive-path-unformed portions orthogonal to the center line. However, it would have been obvious to one skilled in the art at the time the invention was made to form the width of the conductive path being smaller/larger than the width of the insulating paths, in order to match the desired mating component. Claimed variations in relative dimensions, which do not specify a device which performs or operates any differently from the prior art, do not patentably distinguish applicant's invention. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed. Cir. 1984). Workable dimensions would have been a matter of routine experimentation. Variations in the distance would have been obvious minor adjustments without patentable significance. See *In re Aller*, 105 USPQ 233 (CCPA 1955)(Where general conditions of the claim are disclosed in the

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prior art, it is not inventive to discover optimal or workable ranges by routine experimentation).

Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizaka and Simpson, and further in view of Evans (US 3,985,413).

Ishizaka discloses substantially the claimed invention except for the specific conductive path. Evans teaches a conductive path (12) that is constituted by forming one or more plated layers over a base layer made of a metal thick film or a metal thin film (col. 4, lines 25-30), thus providing a more efficient electrical interface. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use different layers, as taught by Evans, to provide a more efficient electrical interface.

Regarding claim 10, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Ag, Ni-Cr or Cu for the base layer; and Sn for the second plated layer as the preferred material in order to provide the desired electrical and mechanical characteristics, and since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishizaka and Simpson, and further in view of Shibata (US 6,123,558).

Ishizaka discloses substantially the claimed invention except for the different colors on opposite sides. Shibata teaches opposite side surfaces having different

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colors, thus facilitating connection in the correct/desired orientation. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use different colors in opposite surfaces, as taught by Shibata, to facilitate connection in the correct/desired orientation.

Response to Arguments

Applicant's arguments filed 12/16/2009 have been fully considered but they are not persuasive.

In response to Applicant's argument that neither Ishizaka nor Simpson disclose "an insulating layer being formed on the insulator", please note that the claim describes a process of manufacturing (formed on) which is incidental to the claim apparatus. Please note that the method of forming a device is not germane to the issue of patentability of the device itself. It is well established that a claimed apparatus cannot be distinguished over the prior art by a process limitation. Therefore, this limitation has been given little patentable weight. In this case, however, both Ishizaka and Simpson disclose an insulator with an insulating outer layer/surface. Simpson teaches the insulating outer layer/surface formed of an epoxy resin (col. 4 lines 65-68). Please note that the claimed language does not require the insulator and the outer insulating layer being formed of different materials, in order to require them to be structurally separate pieces.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Renee Luebke can be reached on (571) 272-2009. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Felix O. Figueroa/
Primary Examiner
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